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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,490	01/08/2001	Michael T.K. Ling	1417Y P 407	4232

7590 11/25/2003

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EXAMINER

NOLAN, SANDRA M

ART UNIT PAPER NUMBER

1772

DATE MAILED: 11/25/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/756,490

Applicant(s)

LING ET AL.

Examiner

Sandra M. Nolan

Art Unit

1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The new language proposed for claim 1 is new matter. See the attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-16.

Claim(s) withdrawn from consideration: 6-10 and 17-111.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 10. Other: A Notice of Draftsperson's Drawing Review (Form PTO 948) is enclosed..

ATTACHMENT TO ADVISORY ACTION

Claims

1. Claims 1-111 are pending. Claims 6-10 and 17-111 are withdrawn as nonelected pursuant to the elections in the responses dated 23 October 2002 (Paper No.7) and 06 February 2003 (Paper No. 10).

Note: Claims 6-10 and 17-18 should have been designated as "withdrawn" on pages 3 and 4 of the proposed amendment dated 03 November 2003 (Paper No. 15).

Non-entry of Proposed Amendment

2. The amendment proposed in Paper No. 15 has not been entered.

Its entry would have inserted new matter into claim 1. The new matter is the phrase "free of polyethylene and polypropylene" (proposed for addition to the last line of claim 1). The phrase is not supported by the original specification or drawings.

The passages referred to in the last line on page 7 of Paper No. 15 do not support the phrase quoted above. Those passages discuss the polymer used in the second layer, but do not state that the layer is free of polyethylene and polypropylene.

Rejections Maintained

3. The 35 USC 103 rejection of claims 1-5, 11, 13 and 15-16 as unpatentable over Rosenbaum et al (WO 95/13918), as set out in section 10 of the 31 July 2003 office action (Paper No. 14), is maintained for reasons of record.

4. The 35 USC 103 rejection of claims 12 and 14 as unpatentable over Rosenbaum in view of Nicola et al (US 6,004,636), as explained in section 11 of Paper No. 14, is maintained for reasons of record.

Response to Arguments

5. Applicant's arguments filed in Paper No. 15 have been fully considered but they are not persuasive.

The arguments will be responded to in the order in which they were presented in Paper No. 15.

On pages 6-7, applicants submit arguments concerning the propriety of the election/restriction requirement in the 18 September 2002 office action (Paper No. 6). While the arguments have been considered, they were not convincing of the impropriety of the election/restriction requirement and it is maintained.

Applicants have already received office actions on claims covering the invention/species they elected earlier. Election is not proper now. Claims 6-10 and 17-18 are nonelected and have not been considered in this action. No further comments concerning the nonelected claims will be made here.

On page 8, applicants argue that Rosenbaum does not teach that its second layer is propylene-free.

However, due to the non-entry of the proposed amendment, the limitation being argued--i.e., a propylene-free second layer--is not recited in the claims. Applicants may not properly argue unclaimed limitations. See MPEP 2145(VI).

On page 8, applicants argue that Nicola teaches a single layer film and does not teach two layers or a polyethylene- or polypropylene-free second layer.

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However, Nicola was cited for teaching polypropylene with styrene/ethylene/-butadiene/styrene copolymers in compositions from which medical bags are made. It was not cited as anticipating claims 12 and 14 (i.e., the claims to which it was applied).

Also, the 35 USC 103 rejection of claims 12 and 14 is based upon the combined teachings of Rosenbaum and Nicola. It is improper to argue against Nicola as if it were applied separately. See MPEP 2145 (IV).

On page 8, in the last paragraph, applicants argue that, even if motivation existed to combine Rosenbaum and Nicola, the combination would teach away from applicants' claims because they both teach a layer containing polyethylene or polypropylene.

However, the claims currently contain no limitation excluding polyethylene or polypropylene. Applicants are arguing a limitation that is not claimed.

Conclusion

Any inquiry concerning this communication should be directed to the Sandra M. Nolan, whose telephone number is 703/308-9545. The Examiner can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the Examiner by telephone are unsuccessful, her supervisor, Harold Pyon, can be reached at 703/308-4251. The general fax number for the art unit is 703/872-9306. The receptionist answers 703/308-0661.



S. M. Nolan
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22 November 2003